

REMARKS

This amendment is being made, in part, based on communications between the Primary Examiner, Mr. Frantz B. Jean (who has assumed responsibility of this application from the previously-listed Primary Examiner, Lesa M. Kennedy) and the undersigned attorney, and the Supervisory Examiner, Mr. Zarni Maung, and the undersigned attorney during the week of July 27, 2004 through August 2, 2004. Claims 1-57 stand rejected on prior art grounds. Claims 1, 2, 4-7, 10, 14, 15, 18-20, 27, 28, 31-33, 40, 46, 47, 50, 52, and 56 are amended herein and claims 3, 12, 16, 25, 29, and 38 are cancelled herein without prejudice or disclaimer. As a result, claims 1, 2, 4-11, 13-15, 17-24, 26-28, 30-37, and 39-52 are all the claims presently pending in the application. Additionally, the abstract, which is objected to, is amended herein. With regard to the claim objections, the claims have been amended to correct the grammatical and/or typographical errors. Applicants respectfully traverse the objections/rejections based on the following discussion.

I. The Objection to the Abstract

The abstract stands objected to because, according to the Office Action, it does not adequately describe the claimed subject matter of the dependent claims. The abstract is amended herein to more fully describe the subject matter provided by some of the dependent claims. The subject matter provided by all of the dependent claims is not (and cannot be) provided in the abstract in order to maintain the length of the abstract to 150 words, which is the limit required by the current USPTO rules and guidelines. In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw this

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objection.

II. The Claim Objections

Claims 7 and 40 are objected to because, according to the Office Action, they contain grammatical/typographical errors. As such, claims 7 and 40 are amended herein to correct the purported errors. In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw these objections.

III. The Prior Art Rejections

Claims 1, 6, 8, 14, 19, 21, 27, 32 and 34 stand rejected under 35 U.S.C. §102(b) as being anticipated by Cardellini, et al. ("Dynamic Load Balancing on Web Server Systems," IEEE Internet Computing, Vol. 3, No. 3, May-June 1999, pp. 28-29), hereinafter referred to as "Cardellini." Claims 40, 42-46, 48-52 and 54-57 stand rejected under 35 U.S.C. §102(a) as being anticipated by Huh, et al. ("Heterogeneous Resource Management," Proc. 9th Heterogeneous Computing Workshop, 1 May 2000, pp. 287-296), hereinafter referred to as "Huh." Claims 2, 15 and 28 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Cardellini, in view of Kleinberg, et al. ("Allocating Bandwidth for Bursty Connections," Proc. 29th ACM Symposium on Theory of Computing, 1997, pp. 664-673), hereinafter referred to as "Kleinberg."

Claims 3-5, 16-18 and 29-31 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Cardellini, in view of Chekuri, et al. ("On Multi-dimensional Packing Problems," Proc. 10th ACM-SIAM Symposium on Discrete Algorithms, 1999, pp. 185-194), hereinafter referred to as "Chekuri." Claims 7, 20 and 33 stand rejected under 35

U.S.C. §103(a) as being unpatentable over Cardellini, in view of Huh. Claims 9-13, 22-26 and 35-39 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Cardellini, in view of Sequent ("Application Region Manager, Creating an Agile Computing Infrastructure Through Application Region Management," Sequent Computer Systems, Inc., Beaverton, Oregon, 1998, pp. 1-8). Applicants respectfully traverse these rejections based on the following discussion.

However, the claimed invention, as provided in amended independent claims 1, 14, 27, 40, 46, and 52 contain features, which are patentably distinguishable from the prior art references of record. Specifically, claims 1, 14, and 27 generally provide, in part, "...discovering utilization patterns of said clients; monitoring said clients to discover said utilization patterns; providing bounds specifying minimum and maximum hosting-service resources for each of said clients; modeling dimensions for client user measures and said utilization patterns; and allocating said resources to said clients dependent on said utilization patterns," and means for performing the above functions. Likewise, claims 40, 46, and 52 generally provide, in part, "monitoring said clients to discover said utilization patterns; providing bounds specifying minimum and maximum hosting-service resources for each of said clients; modeling dimensions for client user measures and said utilization patterns," and means for performing the above functions. These features are clearly not provided in Cardellini or Huh, individually, as admitted in the Office Action.

Moreover, the amended claimed language would require a combined reading of Cardellini, Kleinberg, Chekuri, and Sequent together, which greatly favors non-obviousness, whereby portions of four separate and distinct references would have to be

combined in various forms with one another to try and teach, but failing nonetheless, the elements of the claimed invention. In fact, in the communications between the undersigned attorney and Examiner Jean, it was suggested by Examiner Jean that such a purported combination of four separate references would suggest non-obviousness. Additionally, communications between the undersigned attorney and the Supervisory Examiner, Mr. Zarni Maung, on July 27, 2004 corroborated this conclusion that the combination of four references in this case largely suggests non-obviousness.

Insofar as references may be combined to teach a particular invention, and a purported combination of Cardellini, Kleinberg, Chekuri, and Sequent in various combinations with one another, case law establishes that, before any prior-art references may be validly combined for use in a prior-art 35 U.S.C. § 103(a) rejection, the individual references themselves or corresponding prior art must suggest that they be combined.

For example, in In re Sernaker, 217 USPQ 1, 6 (C.A.F.C. 1983), the court stated: "[P]rior art references in combination do not make an invention obvious unless something in the prior art references would suggest the advantage to be derived from combining their teachings." Furthermore, the court in Uniroyal, Inc. v. Rudkin-Wiley Corp., 5 USPQ 2d 1434 (C.A.F.C. 1988), stated, "[w]here prior-art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself. . . . Something in the prior art must suggest the desirability and thus the obviousness of making the combination."

In the present application, a purported combination of Cardellini, Kleinberg, Chekuri, and Sequent would be improper because it is not legally sufficient or justified to selectively and gratuitously substitute parts of four separate references with one another in order to try to meet, but failing nonetheless, the Applicant's novel claimed invention. As such, all of the claims of this application are, therefore, clearly in condition for allowance, and it is respectfully requested that the Examiner pass these claims to allowance and issue.

As declared by the Federal Circuit:

In proceedings before the U.S. Patent and Trademark Office, the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art. The Examiner can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. In re Fritch, 23 USPQ 2d 1780, 1783 (Fed. Cir. 1992) citing In re Fine, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988).

In view of the foregoing, the Applicants respectfully submit that it would be unobvious to one of ordinary skill in the art to combine the cited prior art references, Cardellini, Kleinberg, Chekuri, and Sequent together in order to try and teach the claimed invention. Moreover, even if Cardellini, Kleinberg, Chekuri, and Sequent were legally combinable, they still fail to teach or suggest all of the features defined by amended independent claims 1, 14, 27, 40, 46, and 52, and as such, claims 1, 14, 27, 40, 46, and 52 are patentable over a combination of Cardellini, Kleinberg, Chekuri, and Sequent together. Further, dependent claims 2, 4-11, 13, 15, 17-24, 26, 28, 30-37, 39, 41-45, and 47-51 are similarly patentable over the combination of Cardellini, Kleinberg, Chekuri, and Sequent, not only by virtue of their dependency from patentable independent claims,

respectively, but also by virtue of the additional features of the invention they define. Thus, the Applicants respectfully request that these rejections be reconsidered and withdrawn.

Moreover, the Applicants note that all claims are properly supported in the specification and accompanying drawings, and no new matter is being added. In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw the rejections.

IV. Formal Matters and Conclusion

With respect to the objections/rejections to the claims, the claims have been amended, above, to overcome these objections/rejections. With respect to the objections to the abstract, the abstract has been amended, above, to overcome these objections. In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw the objections/rejections to the claims and the objections to the abstract.

In view of the foregoing, Applicants submit that claims 1, 2, 4-11, 13-15, 17-24, 26-28, 30-37, and 39-52, all the claims presently pending in the application, are patentably distinct from the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary. Please charge any deficiencies and credit any overpayments to Attorney's Deposit Account Number 09-

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Respectfully submitted,

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